

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JAROSLAV HYNECEK

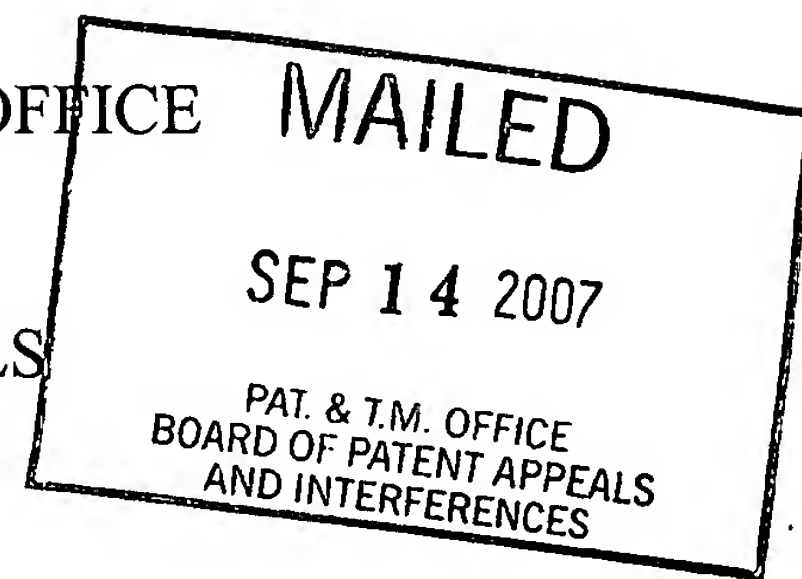
Application No. 10/633,993

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on September 5, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On February 20, 2006, appellant filed an Appeal Brief under 37 CFR § 41.37. A review of the file reveals that the "Summary of Claimed Subject Matter," as required by 41.37(c)(1)(v), is not properly set forth. 37 CFR § 41.37(c)(1)(v) which states:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in



the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The independent claim 11 must be mapped to the disclosure, including specification page and line number, and, if applicable, drawing reference characters.

Correction is required. MPEP § 1205.03 states:

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

In addition, on page 6, under the heading "Grounds of Rejection to be Reviewed on Appeal" the Appellant stated:

Claim 11 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,502,318. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,388,137 in view of U.S. Patent No. 5,760,430.

In response, an Examiner's Answer was mailed on April 18, 2006. While the Answer notes that "the appellant's statement of the grounds of rejection to be reviewed on appeal is correct" [page 2], the Examiner's Answer and the Final Rejection mailed September 20, 2005, the following § 103 rejections were made:

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosiers et al and Kato as applied to claims 11 and further in view of McNutt (4,857,979) . . .

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bosiers et al and Kato as applied to claim 11, and further in view of Hynecek (5,430,481)(IDS)

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hynecek (5,502,318) in view of Hynecek (6,278,142 B1) . . .

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hynecek (5,502,318) in view of Farnow (4,173,064).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bosiers et al and Kato as applied to claim 11 above, and further in view of Hynecek (5,337,340) . . .

A clarification of the claims to be applied in the rejection is required.

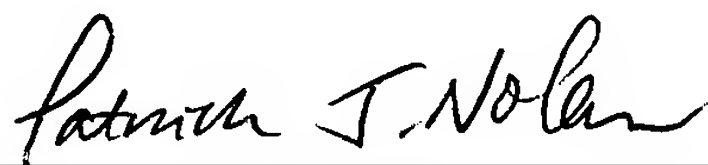
Lastly, the Examiner Answer does not comply with the headings set forth in the new rules under MPEP 1207.2 Correction is required.

Accordingly, it is

**ORDERED** that the application is returned to the Examiner to:

- 1) hold the Appeal Brief of February 20, 2006, defective;
  - 2) notify applicant to file a paper providing a summary of the claimed subject matter as required by 37 CFR § 41.37(c)(1)(v);
  - 3) consider the paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
  - 4) to give a proper explanation of the grounds of rejection;
  - 5) vacate the examiner's answer mailed April 18, 2006 , and issue a reviewed examiner's answer in accordance with the new rules effective September 13, 2004;
- and
- 6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:   
PATRICK J. NOLAN  
Deputy Chief Appeals Administrator  
(571) 272-9797

PJN/dal

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TEXAS INSTRUMENTS INCORPORATED  
P.O. BOX 655474, M/S 3999  
DALLAS, TX 75265